REMARKS

Claims 6 and 23 have been amended to be in independent form, containing all the limitations of claims 1 and 17 from which claims 6 and 23 respectively depended previously. Claims 7 and 24 remain dependent from claims 6 and 23, respectively. Because claims 6 and 23 are not subject to the rejections of record as communicated by Examiner Tung (see below), claims 7 and 24 should also be free of the rejections.

No new matter has been presented, and entry of the amendments is respectfully requested.

Applicants express their thanks for the courtesy of a telephonic discussion on 8 April 2004 between Examiner Joyce Tung and the undersigned. During that discussion, Examiner Tung stated that inclusion of the subject matter of claims 6 and 23 in claims 1 and 17 would obviate the rejections of record, which do not teach or suggest the methods of using "random primer regions" as encompassed by claims 6 and 23. Applicants understand this to indicate that the rejections of at least claims 6 and 23 were misplaced. Applicants respectfully request confirmation of this in the next communication.

Additionally, Applicants wish to point out for the record that the prosecution of the instant application has not followed the MPEP's emphasis on "compact prosecution". Since Applicants' response of February 2003, the Office issued and then withdrew a "final" Office Action mailed 21 May 2003; issued an Office Action mailed 8 August 2003 which contained the identical rejections as those of the Action mailed 21 May 2003; and maintained those rejections in the instant "final" rejection mailed 11 February 2004 despite the fact that, as noted above, at least claims 6 and 23 were inappropriately included in the rejection.

Thus over ONE YEAR (February 2003 to the present), since the October 25, 2001 filing date of the instant application, has been effectively lost during the assertion of misplaced rejections against at least claims 6 and 23. Accordingly, Applicants respectfully request that in the event one or more claims continue to be held as rejected, the next communication raise all issues in accordance with the principles of "compact prosecution".

Rejections under 35 U.S.C. § 103(a)

Claims 1-32 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Lin et al. (US 2002/0137709), hereafter Lin et al. (2002) in view of Adams et al. (USP 6,297,365). Applicants have carefully reviewed the statement of the rejection as well as the cited references and respectfully submit again that no *prima facie* case of obviousness has been presented.

The statement of the rejection in the Action mailed 11 February 2004 asserted that Applicants' position was unpersuasive because it was arguing "limitations ... not recited in claims 1 and 17". Applicants respectfully traverse.

MPEP 2111, and the cases cited therein, set forth the standard that the claims are to be read light of the specification to thereby interpret limitations explicitly recited in the claim. Applicants had pointed out in the last response of 12 November 2003 (mailed 10 November 2003) that application of this standard includes the fact that the term "random primer region" in claims 1 and 17 is to be read in light of the specification at page 16, lines 2-5, which states that a "region" of "a polynucleotide or oligonucleotide is a contiguous sequence of 2 or more bases." Thus Applicants' position is entirely proper, and distinct from, the prohibition against "reading limitations of the specification into a claim" by adding disclosed limitations which have no express basis in the claim."

Accordingly, and because neither Lin et al. (2002) or Adams et al. disclose or suggest the use of a random primer region as recited in claims 1 and 17, the rejection of at least claims 1-5, 8-22, and 25-32 should be withdrawn.

With respect to claims 6, 7, 23 and 24, Applicants point out that they continue to be directed to methods comprising the use of a random primer region comprising at least about six nucleotides. Given the deficiencies of Lin et al. (2002) and Adams et al. as noted above, and the telephonic discussion with Examiner Tung, the rejection of these claims based upon these two references should be withdrawn.

Additionally, Applicants again point out, for at least the third time during the prosecution history of this application, that the statement of the instant rejection appears to be

based upon critical misunderstandings of what Lin et al. (2002) disclose. Applicants respectfully request clarification of the instant rejection as not relying on the misunderstandings pointed out in Applicants' last response of November 2003.

In light of the above, Applicants respectfully submit that no *prima facie* case of obviousness has been presented, and this rejection may be properly withdrawn.

Claims 1-32 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shannon (USP 6,132,997) in view of Adams et al. (USP 6,297,365). Applicants have carefully reviewed the statement of the rejection as well as the cited references and respectfully submit again that no *prima facie* case of obviousness has been presented.

The statement of the rejection in the Action mailed 11 February 2004 asserted that contrary to Applicants' position, Shannon discloses an "oligo dT primer that contains some variable positions at its 3' end". Applicants respectfully traverse because Shannon and Adams et al. fail to teach or suggest the use of that primer in a manner as encompassed by the instant claims.

For example, there is no disclosure or suggestion in Shannon or Adams et al. of the use of random primers for the synthesis of the second strand of the duplex cDNA molecule as required by element a), subelements iv) and v) of claims 1 and 17. Instead, Shannon discloses the production of RNA molecules that are antisense relative to a starting mRNA template. The starting template is used with a promoter linked oligo dT primer that contains some variable positions (see column 4, lines 50-63) to produce a promoter linked duplex cDNA molecule that is transcribed into RNA in the presence of a reverse transcriptase that is rendered incapable of RNA-dependent DNA polymerase activity. *There is no disclosure of the use of any random primers for the synthesis of the second strand of the duplex cDNA molecule.* This is in complete contrast to the requirements of claims 1 and 17 as discussed above. To the contrary, the synthesis of the second strand is disclosed as using RNase H activity (see column 6, lines 28-49).

The above is consistent with Shannon's Example 1 (columns 9-11), where no random primers are used to produce a second cDNA strand. Instead, a single primer is used to produce a double stranded template. Shannon's Example 2 (columns 11-14) also does not

describe using random primers to produce a second cDNA strand (see column 13, lines 17-29). Shannon's Appendix A (columns 17-18) also does not disclose using random primers to synthesize the second cDNA strand. Instead, RNase H activity is used (see column 15, line 43, and column 17, lines 8-29).

Therefore, Shannon does not disclose all the elements of the claimed invention as required to support an allegation of obviousness. Because the deficiencies of Shannon are not remedied by Adams et al., Applicants respectfully submit that no combination of Shannon and Adam et al. can lead the artisan of ordinary skill to the instantly claimed invention. Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness has been presented, and this rejection may be properly withdrawn.

Claims 1-32 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Lin et al. (US 2003/0022318), hereafter Lin et al. (2003), in view of Adams et al. (USP 6,297,365). Applicants have carefully reviewed the statement of the rejection as well as the cited references and respectfully submit that no *prima facie* case of obviousness has been presented.

As an initial matter, Applicants are confused by the allegations made in the Action mailed 11 February 2004. It states that

> "the enzymatic activities of Lin et al. (2003) are not simultaneously used and primer are not simultaneously used. However, claims 1 and 17 do not recite the limitation which requires the enzymes and primers simultaneously used in the method. Thus the limitations discussed in the response are not in the claims."

Applicants respectfully submit that the above reflects a misunderstanding of the Lin et al. (2003) and possibly a misunderstanding of the pending claims. As Applicants previously stated, and contrary to the above, Lin et al. (2003) only disclose the simultaneous use of reverse transcriptase, DNA-dependent DNA polymerase, and RNA polymerase activities in

the presence of both a promoter linked primer and another primer (see page 8, paragraphs 0099 to 0105).

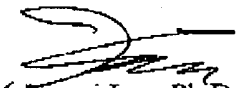
The claimed methods, in agreement with the above quoted passage, do not encompass the simultaneous use of enzymes and primers. This is clearly indicated by at least element a), subelement iii) of claims 1 and 17, where excess amounts of the primer used with the reverse transcriptase in subelement ii) is *degraded by exonuclease activity* after reverse transcription. Because neither Lin et al. (2003) nor Adams et al. disclose or suggest the methods as claimed with these claim elements, not all the elements of the claimed invention are present as required to support an allegation of obviousness.

Therefore, Applicants respectfully submit that no combination of Lin et al. (2003) and Adam et al. can lead the artisan of ordinary skill to the instantly claimed invention. Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness has been presented, and this rejection may be properly withdrawn.

Conclusion

In light of the above, Applicants respectfully submit that the claims are allowable and request early indication to that effect with the passage of the instant application to issue. If the Examiner believes further discussion would expedite prosecution of this application, she is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,



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